REMARKS

Claims 1-27 are presented for further examination. Claims 1, 3, 7, 11, 15, and 19 have been amended. Claims 20-27 are new.

In the final Office Action mailed August 26, 2003, the Examiner rejected claims 1-6, 11-15, and 17 under 35 U.S.C. § 103(a) as obvious over Pederson (of record) in view of Szabo (of record). Remarks accompanying the rejection state that changing the location of the flexible sheet from the location shown by Pederson as modified by Szabo and changing the location of the lines, absent and criticality, is only considered to be an obvious modification of the ruler disclosed by Pederson and modified by Szabo since the "courts have held that there is no invention in shifting the position if the operation of the device would not be thereby modified." Claims 7-10, 15, 16, 18, and 19 were finally rejected under 35 U.S.C. § 103(a) as obvious over McCutchen et al. (of record). Remarks accompanying this rejection state, *inter alia*, that the term "removably" does not "structurally distinguish the claimed invention because any structure may be considered to be 'removably' if so desired as long as the structure may be removed by any means, if so desired."

Applicant respectfully disagrees with the basis for the rejections and requests reconsideration and further examination of the claims.

With respect to the operation of the cited reference to Szabo, Szabo teaches a band of "resilient and non-slipping material" secured by "adhesive, or the like," in a groove that is formed in the ruler's surface. Moreover, Szabo teaches altering the ruler before applying the band, wherein a "groove 16 is cut in such a manner that one longitudinal edge portion 18 of the band projects below the lower surface of the strip 11 as shown in Figure 3." (See column 1, line 50-column 2, line 2).

Szabo further teaches at column 2, lines 9-15:

> It should be understood that the band 17 possesses sufficient resiliency to permit the lower surface 13 of the ruler to come in contact with the work, if desired, this, of course, being accomplished by exerting downward pressure upon the upper surface 12 of the ruler, as will be clearly understood.

Thus, in Szabo, the edge 18 of the band "projects below the lower surface 13" of the straight edge forming a non-planar surface. In operation, Szabo teaches that the ruler must be

pressed down on the band with sufficient force to overcome the resiliency of the band and "permit the lower surface 13 of the ruler to come in contact with the work, if desired...."

Thus, Szabo teaches modifying the straight edge by forming a groove therein, which is cut to receive the band in a manner to force the longitudinal edge of the band below the lower surface of the straight edge. Szabo teaches securing of the band in the groove with adhesive such that the band is intended not to be removed. Thus, the band is "secured" to the straight edge and there is no intention of removing the same from the straight edge. Any attempt to do so will either result in altering the band, or altering the straight edge by leaving portions of the band or the adhesive or both on the straight edge.

Pederson, as previously discussed in the first Amendment, teaches a non-transparent ruler having a "roughened bottom surface." Although Pederson teaches the straight edge being formed of "metal, glass, or other suitable material" (see lines 33-39), Pederson specifically teaches roughening the bottom surface thereof to provide a non-slip surface. Thus, if Pederson were formed of transparent glass, roughening the bottom surface would make the glass opaque or at most translucent, but in no event would the glass be transparent. Thus, Pederson clearly teaches away from the present invention.

Any combination of Pederson and Szabo would clearly teach away from the present invention because such a the ruler would not be transparent, adhesive would be used to attach a non-slip material to the ruler, and the non-slip material would *not* form a planar non-slip surface between the ruler and the material to be measured and cut.

McCutchen et al. clearly teaches permanent attachment of the buffer strips to the template (see column 3, lines 6-7) and does not teach or suggest the buffer elements being made of transparent material or attached in such a way that the buffer strips can be removed without altering the template or leaving adhesive on the template or without altering the buffer strips.

Turning to the claims, claim 1 is directed to a transparent sheet of rigid material having a plurality of lines formed on a first side thereof; and a transparent sheet of non-static cling, flexible material sized and shaped to only cover the entire first side of the sheet of rigid material, the sheet of flexible material *temporarily* adhered to the first side of the sheet of rigid material with *surface adhesion only* and configured to provide a *planar* surface that resists

slipping on the material *and does not alter the first side of the sheet of rigid material when applied thereto or removed therefrom.*

As disclosed at page 4 of the specification, the claimed embodiments of the present invention provide a non-slip surface "that is easily applied and removed... can be interchanged between rulers... can be marked on for a visual aid on the underside of the ruler... can be printed on prior to applying to blank plastic, does not damage or alter the ruler...." As discussed above, nowhere does the combination of Pederson and Szabo teach or suggest the claimed combination recited in claim 1. Neither reference taken alone or in combination thereof teaches "temporarily" adhering a sheet of flexible material to a sheet of rigid material with "surface adhesion only." Neither of these references taken alone or in any combination thereof teaches or suggests the flexible sheet of material not altering the first side of the sheet of rigid material when applied thereto or removed therefrom. Rather, Szabo clearly teaches the use of adhesive and does not teach or suggest temporarily adhering the flexible sheet with surface adhesion only. In Szabo, the intended use of the band is to have it "secured by adhesive" or the like to a groove on the side of the straight edge strip. Any attempt to remove the band would result in altering the band, the straight edge strip, or leaving the adhesive or portions thereof on the straight edge strip. In view of the foregoing, applicant respectfully submits that claim 1 is allowable over the combination of Pederson and Szabo.

Claim 3 is directed to a tool for use in measuring and marking material that comprises a transparent sheet of rigid material having first and second opposing planar sides and a plurality of lines formed on one of the first and second opposing planar sides; and a sheet of non-static cling flexible material sized and shaped to cover only the entire first side of the sheet of rigid material, the sheet of flexible material adhering to the first side of the sheet of rigid material by surface adhesion only and configured to provide a planar, non-slip surface and to leave no adhesive on the first side of the sheet of rigid material when removed therefrom. As discussed above with respect to claim 1, Szabo clearly teaches the use of adhesive and Pederson clearly teaches roughening the surface of the ruler such that there would be no transparency, the non-slip surface would not be planar, and adhesion would not be by surface adhesion only. In

view of the foregoing, applicant respectfully submits that claim 3 is clearly allowable over the combination of Pederson and Szabo.

Dependent claims 2, and 4-6 are allowable for the reasons why their respective independent claims are allowable.

Independent claim 7 is directed to a method of making a transparent tool for use with measuring and marking material, the method comprising providing a transparent sheet of rigid material, providing a transparent sheet of non-static cling, non-slip flexible material, sizing the sheet of flexible material to substantially cover only one of the first and second opposing planar sides of the rigid material, and placing the sized sheet of flexible material on only one of the first and second opposing planar sides of the sheet of rigid material to substantially cover only the one side of the sheet of rigid material and to provide a removable non-slip bearing surface between the material to be measured and marked. Claim 7 further recites the flexible material adhering to the sheet of rigid material by surface adhesion only to remain in place when facing downward and to be easily removed from the sheet of rigid material without altering the sheet of rigid material and the flexible material.

McCutchen et al. clearly teaches permanently adhering the buffer element to the template. Any attempt to disconnect the two or removable detach them will result in alteration to either the template, the buffer element, or both because of the "permanent" attachment. Applicant respectfully submits that claim 7 is allowable over McCutchen et al. for this reason as well as for the reason that surface adhesion only is used to couple the flexible material to the rigid material, which is in opposite McCutchen et al.

Independent claim 11 is directed to a tool for measuring and marking material that comprises a transparent sheet of rigid material and a sheet of non-static cling, flexible material having a plurality of lines formed on one of first and second opposing sides adhered to a first side of the sheet of rigid material with surface adhesion only and configured to provide a removable non-slip surface and to not alter the flexible material and the transparent sheet of rigid material when the flexible material is applied to and removed from the transparent sheet of rigid material.

As discussed above, the combination of Szabo and Pederson clearly teaches the use of adhesive and roughening a surface of the rigid material such that transparency would be

lost and easy removability is also lost, resulting in alteration of the template and the band. Clearly the combination of Szabo and Pederson fails to teach or suggest the tool of claim 11. Consequently, applicant submits that claim 11 as well as dependent claims 12-14 are clearly allowable over the combination of Szabo and Pederson.

Independent claim 15 is directed to a tool for use in measuring and marking material that includes a transparent sheet of rigid material and a transparent sheet of non-static cling, flexible material removably adhered to only one of the first and second sides of the sheet of rigid material to provide a planar non-slip surface between the transparent sheet of rigid material and the material to be measured and marked and to not alter the sheet of rigid material when the sheet of flexible material is applied thereto or removed therefrom.

As discussed above, the combination of Szabo and Pederson fails to teach or suggest a planar, non-slip surface between a transparent sheet of rigid material and the material to be measured and marked. Szabo and Pederson also fail to teach or suggest not altering the sheet of rigid material when the sheet of flexible material is applied thereto or removed therefrom. Likewise, McCutchen et al. fails to teach or suggest these features. In view of the foregoing, applicant submits that claim 15 as well as dependent claims 16-18 are allowable.

Independent claim 19 is directed to a tool for measuring and marking material that has a transparent sheet of non-static cling, flexible vinyl material having plasticizers therein and having opposing first and second sides with a plurality of lines formed on one of the first and second sides; and a transparent sheet of rigid material having opposing first and second sides with the sheet of flexible material removably adhered by surface adhesion only to only one of the first and second sides to provide a non-slip surface between the transparent sheet of rigid material and the material to be measured and marked and to not alter either one of the sheet of flexible material and the sheet of rigid material when adhered together or removed apart. Claim 19 contains limitations similar to those recited in claim 15 and includes the additional limitation of flexible vinyl material having plasticizers therein. Applicant submits that claim 19 is clearly allowable over McCutchen et al. because McCutchen et al. does not teach or suggest the combination recited therein.

New claims 20-27 all recite limitations discussed above with respect to one or more of claims 1-19. Applicant submits that new claims 20-27 are in condition for allowance for the reasons why claims 1-19 are allowable.

In view of the foregoing, applicant submits that all of the claims in this case are clearly in condition for allowance. In the event the Examiner finds minor informalities that can be resolved by telephone conference, the Examiner is urged to contact applicant's undersigned representative by telephone at (206) 622-4900 in order to expeditiously resolve prosecution of this application. Consequently, early and favorable action allowing these claims and passing this case to issuance is respectfully solicited.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC

E. Russell Tarleton
Registration No. 31,800

ERT:aep

Enclosure:
Postcard

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

840070.404 / 430398_1.DOC